

DETAILED ACTION

This action is in response to applicant's communication on 03/14/2007, wherein claims 1-6 and newly added claims 11-16 are currently pending.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's "determining step" does not give sufficient direction or guidance as to how one skilled in the art would "determine whether the report supports filing a claim..." without undue experimentation. After reviewing applicant's specification, the only support found was for making this determination was found at, "[0016] An employee or agent of the entity will review the information to determine if it is sufficient

in detail and scope, as at 6. If the information is deemed sufficient, a file is opened, as at 8.” See 101 rejection below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-6 and 11-16** are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).
3. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.
4. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without

the use of a particular apparatus. Thus, claims 1-6 and 11-16 are non-statutory since they may be preformed within the human mind.

1. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidence by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidence by, but not limited to, a real or actual effect. In the present case, the "determining step" as to whether to open a claim is subjective. Thus because the determination is subjective for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results are required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoo (US 5,895,450).

8. With respect to **Claim 1**:

Shoo discloses a method of facilitating "whistle-blowing" by one or more anonymous individuals, the method comprising the steps of:

Main Entry: **whis-tle-blow-er** *

Pronunciation: \-,blō-ər\

Function: *noun*

Date: 1970

: one who reveals something covert or who informs against another <pledges to protect *whistle-blowers* who fear reprisals — *Wall Street Journal*>

— **whis-tle-blow-ing** * \-,blō-ɪŋ\ *noun*

operating an independent service organization to which a person or persons may anonymously submit a report or specific instances of fraud, misconduct, and other victimization of and by other persons or entities (Shoo col. 1, lines 56-62, "the present invention provides a method and apparatus for handling complaints that allows complainants to lodge anonymous complaints against subjects, informs the subjects of the complaints, permits the subjects to respond to the complaints, encourages settlements of the complaints and holds

the parties to the complaints accountable for their conduct while attempting to resolve the complaints.”),

negotiating with at least one of the victimized and victimizing person or entity to obtain the reward on behalf of the reporting person or persons making the report (Shoo col. 5, lines 12-19, “...it can be used as a private message area or as a password for entry into some type of private forum for negotiations between the complainant and the subject. This allows the complainant and subject to privately negotiate a settlement to the dispute without requiring the complainant to meet the subject face-to-face.”), and

receiving a determination by one of the victimized and victimizing person or entity as to whether a reward will be granted for having made the report, if a reward is to be given, receiving same (Shoo fig 7, item 738), and

in a case where said reward is obtained, collecting said reward from the victimized person or entity either directly for the reporting person or persons anonymously or indirectly by donating it on behalf of the reporting person or persons to a nonprofit or governmental entity specified by the reporting person or persons (Shoo col. 12, lines 15-24, “At any time during the use of the apparatus, the program may require any of the users to pay a fee. For example, the program may require a user to pay a fee before posting a complaint or require a subject to pay a fee before posting a response to a complaint. A portion of these collected fees can be used to pay or reward, and thus encourage judges, jurors, and third party witnesses to participate in a complaint resolution process.”).

Shoo does not explicitly disclose determining whether the report supports filing a claim to obtain a reward on behalf of the reporting person or persons, and in a case where the report supports the claim, filing the claim with the victimized person or entity. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to screen reports in order to ferret out any meritless claims. This type of screening would have been obvious since any time a financial reward is at stake people make claims which would not otherwise occur had there not been this chance for fiscal gain. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Shoo so as to have included a determination step, in order to have improved the efficiency of the system, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

3. With respect to **Claim 2**:

Shoo discloses wherein the reward is collected and passed to the specified entity on behalf of the anonymous reporting person or persons, and the reward is acknowledged by the specified entity's publishing notice of the donation by the independent service organization with a code chosen by one of the organization and the reporting person or persons, thereby giving notice of completion of the whistle blowing process (Shoo col. 2, lines 7-13, "The central computer is also programmed to provide public access to the data records to permit viewing of the corresponding complaints, responses, and settlements for allowing other users to gauge the conduct of the

subjects and to encourage the subjects to respond to the complaints in a timely and satisfactory manner.”).

4. With respect to **Claim 3**:

Shoo discloses wherein anonymous communication is provided between the service organization and the reporting person or person by way of postings on a publicly accessible bulletin board of the service organization (Shoo col. 2, lines 7-13, “The central computer is also programmed to provide public access to the data records to permit viewing of the corresponding complaints, responses, and settlements for allowing other users to gauge the conduct of the subjects and to encourage the subjects to respond to the complaints in a timely and satisfactory manner.”).

5. With respect to **Claim 4**:

Shoo discloses wherein the bulletin board is an electronic one that is accessible over a global communications network and the reporting person or person selects his, her, or its own identifying code (Shoo col. 2, lines 63-66, “The method of the present invention is preferably implemented with a programmed central computer, a plurality of access terminals, and a communications network coupling the central computer with the access terminals.” and col. 6, lines 43-46, “the apparatus 10 does not disclose the actual names of the complainants to the subjects so that the complainants may remain anonymous. This further encourages users to file complaints with the apparatus.”).

6. With respect to **Claim 5**:

Shoo discloses wherein the information is offered to the victimized person or entity and a reward is negotiated by the organization with the victimized person or entity

for providing the information (Shoo [abs], "...a routine for negotiating a settlement of the complaint.").

7. With respect to **Claim 6:**

Shoo discloses wherein the organization retains a fee from the reward monies and transfers only the balance to reporter or the specified entity (Shoo col. 12, lines 15-24, "At any time during the use of the apparatus, the program may require any of the users to pay a fee. For example, the program may require a user to pay a fee before posting a complaint or require a subject to pay a fee before posting a response to a complaint. A portion of these collected fees can be used to pay or reward, and thus encourage judges, jurors, and third party witnesses to participate in a complaint resolution process.")

8. With respect to **Claims 11-16:**

9. Shoo discloses operating an independent service organization to which a person or persons may anonymously submit a report or specific instances of fraud, misconduct, and other victimization of and by other persons or entities (Shoo col. 1, lines 56-62, "the present invention provides a method and apparatus for handling complaints that allows complainants to lodge anonymous complaints against subjects, informs the subjects of the complaints, permits the subjects to respond to the complaints, encourages settlements of the complaints and holds the parties to the complaints accountable for their conduct while attempting to resolve the complaints."). Shoo additionally contemplates governmental uses while discussing the background of the invention. However, Shoo does not explicitly disclose wherein the specific instance of fraud,

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misconduct, and other victimization is a fraud committed upon a governmental body, wherein the fraud committed upon the governmental body is tax fraud, an instance of environmental pollution, or defrauding of a business entity.

10. It would have been obvious to one of ordinary skill and creativity in the art to have used the invention disclosed in Shoo for any purpose to which the art pertains. Here, applicant's intended would not be outside the realm of Shoo. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Shoo to be used to report specific instance of fraud, misconduct, and other victimization is a fraud committed upon a governmental body, wherein the fraud committed upon the governmental body is tax fraud, an instance of environmental pollution, or defrauding of a business entity since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

9. Applicant's arguments filed 3/14/08 have been fully considered but they are not persuasive. Applicant's arguments have been addressed in the above action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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